

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-21 are now present in this application. Claims 1 and 21 are independent.

By this Amendment, claims 9 and 13-17 have been amended and claim 21 has been added. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants note that the Examiner has not acknowledged Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Applicants respectfully request that the examiner make such an acknowledgement in the next Office Action.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statement (IDS) filed on June 28, 2006, and for providing Applicants with an initialed copy of the PTO/SB/08 form filed therewith.

Claim Amendments

Applicants have amended claims 9, 15, 19 and 20 in order to correct minor typographical errors, and to place the claims in better form. The claim amendments are not being made in response to any statutory requirement for patentability, and have not been narrowed in scope. Instead, the claims have been amended merely to recite the subject matter therein more clearly.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 14, 16 and 17 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the language of claims 14 contain two sets of ranges. However, claim 14 does not include such language. Instead claims 13 and 16 contain the language in issue. Accordingly, this rejection is treated as a rejection of claims 13, 16 and 17.

The Examiner also correctly points out that claim 14 (sic:17) is incomplete.

In order to overcome this rejection, Applicants have amended claims 13 and 16 to remove one set of ranges in each of those claims, and have amended claim 17 to complete the claim. Claim 17, as amended, now includes subject matter of claim 17 that was originally filed but was inadvertently omitted from amended claim 1, which as filed in the First Preliminary Amendment, thereby correcting each of the problems specifically pointed out by the Examiner. Applicants respectfully submit that the claims, as amended, particularly point out and distinctly claim the

subject matter which Applicants regard as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 4-11 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,316,688 to Niederer. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or

argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *See Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *See Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Claim 1 recites apparatus for feeding gimmicks to a main conveyor of a conveyor line, wherein the apparatus is provided with a sliding table having at least one free side where an operator can position himself, and with at least one conveyor, the at least one conveyor being provided with compartments each having such dimensions that one gimmick is receivable therein, and wherein an inlet of the at least one conveyor aligns with the sliding table.

Niederer simply does not disclose a sliding table, either explicitly or inherently.

Niederer does not explicitly disclose a sliding table. Whereas the element in Niederer

which is indicated by the Examiner as being a sliding table, Niederer discloses, in col. 2 lines 1-5 that element 2 is any suitable source for supplying eggs or articles, "which may be an egg grader, an egg candler, a conveyor, or any other form of equipment designed to feed the eggs or articles to the egg-packing equipment . . ." Moreover, the only illustration of element 2 in Fig. 1, shows element 2 as a conveyor with a belt and pulley.

In regard to whether Niederer inherently discloses that element 2 is a sliding table, Applicant references the case law cited above, which clearly points out that for something to be inherently disclosed, it cannot be just possibly disclosed and it cannot just be probably disclosed. Rather, it must necessarily disclosed. Unfortunately, Niederer fails to necessarily disclose that its device for supplying eggs is a sliding table.

Furthermore, with respect to claim 4, it would appear that the only compartments disclosed by Niederer are defined by a pair of belts 4, and there are only six pairs of belts, or compartments, shown in Fig. 1. Accordingly Niederer does not anticipate claim 4, which recites eight to fifteen compartments.

Furthermore, with respect to claim 7, the Office Action incorrectly states that an egg is actively pushed onto conveyor line 34 by delivery means 64. Applicants respectfully submit that element 64 of Niederer merely drops egg cartons onto belt 34, and has nothing whatsoever to do with pushing eggs onto belt 34.

Furthermore, with respect to claim 9, all that Niederer does at the dispensing end of belt 4 is to retard the eggs using retarding members 18 and uses a plurality of microswitches/sensors 33 connected in series to determine when all egg retarding members 18 are engaged, and the

plurality of eggs (six eggs corresponding to the six belt pairs) are in position for transfer to the packing conveyor 34. This is not what is recited in claim 9 and does not anticipate what is recited in claim 9 because Niederer does not disclose a control being arranged for driving Niederer's conveyors until its compartment (presumably the space between a pair of belts that holds plural eggs) and/or a receiving pocket (again, presumably the space between a pair of belts that holds plural eggs) is filled with a gimmick. In actuality, Niederer's control waits far beyond the time that its compartment (space between a pair of belts that holds plural eggs) is filled with an egg. In fact, it would appear that Niederer's compartment is so big (long) that it can never be filled with an egg.

Accordingly, Niederer does not anticipate independent claim 1, or dependent claims 2, 4-9, 10, 11 and 17.

Thus, reconsideration and withdrawal of this rejection of claim 1 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 3, 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Niederer in view of U.S. Patent 5,209,339 to Antonissen. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C.

§103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a

prima facie case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicants respectfully submit that Niederer does not disclose the invention recited in claim 1, from which claims 3, 18 and 20 depend and Antonissen is not applied to remedy the aforementioned deficiencies of Niederer with respect to claim 1. So, no matter how Antonissen is applied, the so modified version of Niederer cannot possibly disclose, suggest, or otherwise render obvious, the claimed invention.

Furthermore, with respect to claim 20, Niederer only discloses six elongated egg containing compartments, so that the eight to 15 compartments are not disclosed, suggested, or rendered obvious.

Reconsideration and withdrawal of this rejection of claims 3, 18 and 20 are respectfully requested.

Claim 12 stands rejected under 35 USC §103(a) as being unpatentable over Niederer in view of U.S. Patent 4,604,704 to Eaves. This rejection is respectfully traversed.

Applicants respectfully submit that Niederer does not disclose the invention recited in claim 1, from which claim 12 depends and Eaves is not applied to remedy the aforementioned deficiencies of Niederer with respect to claim 1. So, no matter how Eaves is applied, the so modified version of Niederer cannot possibly disclose, suggest, or otherwise render obvious, the

claimed invention.

Reconsideration and withdrawal of this rejection of claim 12 are respectfully requested.

Claims 13-16 stand rejected under 35 USC §103(a) as being unpatentable over Niederer. This rejection is respectfully traversed.

Applicants respectfully submit that Niederer does not disclose the invention recited in claim 1, from which claims 13-16 depend and the proposed modifications of Niederer are not applied to remedy the aforementioned deficiencies of Niederer with respect to claim 1. So, no even if one of ordinary skill in the art were properly motivated to so modify Niederer, the so modified version of Niederer cannot possibly disclose, suggest, or otherwise render obvious, the claimed invention.

Furthermore, with respect to claim 13, this claim recites, for example, that at each driving event the compartments are moved forward at least one compartment. However, this cannot happen in Niederer because its egg compartments are elongated pairs of belts and the concept of moving such a compartment forward one compartment has no meaning.

Thus, reconsideration and withdrawal of this rejection of claims 13-16 are respectfully requested.

Claim 21

Claim 21 has been added for the Examiner's consideration. Independent claim 1 recites a combination of features, including apparatus for feeding three dimensional products to a main

conveyor of a conveyor line and at least one other conveyor being provided with compartments each having dimensions to receive and convey one of the three dimensional products, wherein the apparatus is provided with a sliding table having at least one free side where an operator can position himself for sliding the three dimensional products on the sliding table toward the at least one other conveyor, an inlet of the at least one conveyor being aligned with the sliding table.

Applicant respectfully submits that this combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record.

Consideration and allowance of claim 21 is respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 10/584,799
Art Unit 3651

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Reply to Office Action dated May 5, 2009
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: August 5, 2009

Respectfully submitted,

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